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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) | |
|---|--|---|-----------------------------|
| | | 0026119.0136DUS1 | |
| | | Application Number 09/696,765-Conf. #3130 | Filed October 25, 2000 |
| | | First Named Inventor Bob LAMOUREUX et al. | |
| | | Art Unit 3627 | Examiner J. A. Fischetti |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> attorney or agent of record. Registration number _____</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. 35,120</p> <p>Signature:  Irah H. Donner Typed or printed name</p> <p>(212) 230-8800 Telephone number</p> <p>October 3, 2006 Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p> <p><input type="checkbox"/> *Total of 1 forms are submitted.</p> | | | |

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted by facsimile to the Patent and Trademark Office, facsimile no. (571) 273-8300, on the date shown below.

Dated: October 3, 2006

Signature:  (Irah H. Donner)

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Attorney Docket No. 26119-136D US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Bob Lamoureux et al. Confirmation No.: 3130
Application No. : 09/696,765 Group Art Unit: 3627
Filed : October 25, 2000 Examiner: J. A. Fischetti
For : ELECTRONIC SALES SYSTEM

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

In response to the Advisory Action mailed August 28, 2006 and in response to the Final Office Action mailed April 3rd, 2005 ("the Final Action"), Applicants submit a Notice of Appeal, and the following Pre-Appeal Brief Request for Review.

Restriction History

The present Application is related to U.S. Application number 09/697,024 ("the '024 application") and U.S. Application number 09/696,754 ("the '754 application"). The '024 Application was filed with 43 claims and the Examiner required restriction and listed nine groups of inventions. The '754 Application was filed with 57 claims and the Examiner required restriction and listed seven groups of inventions. Further restriction was required, among 3 groups, in the '754 application when 16 new claims were added. In addition, the Examiner indicated that the selected group of the '754 application had plural species and accordingly required selection of a species in the selected group. As detailed below, the present Application was filed with 32 claims and has been restricted into 5 inventions with one of the inventions having seven distinct species.

In the Office Action dated November 3, 2003, the Examiner restricted the present application to four inventions. In the Response to Restriction Requirement filed December 23, 2004, the Applicants elected group I consisting of claims 1-26. In the Office Action dated March 3, 2004, the Examiner then indicated that the elected claims 1-26 contained claims directed to seven patentably distinct species. In the Response to Restriction Requirement filed August 9, 2004, the Applicants elected the species defined by claims 16, 17, and 18. The Office Action filed November 24, 2004 was the first to contain claim

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rejections and in the Reply to Office filed May 24, 2005, the Applicants added 3 new claims. In the Office Action dated August 5, 2005, the Examiner indicated that the new claims required the present Application to be restricted into two. Applicants elected group II, containing new claims 33-35, in the Response to Restriction Requirement filed August 22, 2005. Thus, between the three related applications, it appears the Examiner has found 30 groups of patentably distinct subject matter. Claims 33-35 of the present application are pending and twice rejected. Applicants respond to the rejections below.

Rejections Under 35 U.S.C. § 103(a)

Generally speaking, Applicants' invention, as defined by independent claims 33-35, is directed towards a networked commercial interaction management method. In the Final Action, the Examiner maintained the rejection of claims 33-35 under 35 U.S.C. § 103(a) as being allegedly obvious over the combination of U.S. Patent 6,721,747 to Lipkin and U.S. Patent 6,389,403 to Dorak et al. For the reasons set forth below, Applicants respectfully submit that these rejections should be withdrawn.

A. Lipkin is Not Prior Art

It was noted on page 7 of the Current Reply and page 10 of the Previous Reply that provisional Application No. 60/176,137, filed January 14, 2000, to which Lipkin claims benefit is not prior art to the current application, which was filed on October, 25, 2000. On page 4 and 5 of the Current Action, the Examiner cited portions of the '137 provisional to support his assertion that "one would derive the invention described in [Lipkin] from [the '137 provisional]." However, none of the portions of the '137 provisional cited show or suggest, for example, "based upon at least part of [a] first set of personal profiles and at least part of [a] second set of personal profiles, making at least part of the second set of personal profiles available," as required by claim 33. A similar argument applies to claims 34-35. Accordingly, the Lipkin prior art reference is NOT prior art to the present application. Therefore, the rejection should be withdrawn, and such action is respectfully requested.

B. The Examiner Has Not Met the Requirements of 37 CFR § 1.104(c) or 35 U.S.C § 132 in Regard to Claim 33

In the Reply to Office Action filed on January 18, 2006 ("the Previous Reply"), the Applicants' noted that the Examiner had failed to reasonably identify where several limitations of the claims are shown or suggested in the Lipkin reference (page 13, paragraph 1). In the Reply to Office Action filed August 2, 2006 ("the Current Reply"), Applicants again noted several limitations that were not reasonably

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identified and noted that the Final Action was insufficient because the Examiner gave no further indication of what in Lipkin he believes to show or suggest the claimed limitations (page 8, paragraph 1). Accordingly, Applicants submitted arguments on pages 8-9 of the Current Reply, which are presented again below, that the Examiner has not met the requirements of 37 CFR § 1.104(c), which, as quoted below, requires:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified (emphasis added).

Claim 33 requires, for example,

based upon at least part of the first set of personal profiles and at least part of the second set of personal profiles, making at least part of the second set of personal profiles available.

In explaining what the Examiner believes to show or suggest these claim limitations, he states only, referring to Lipkin, that "Match Agents and Information Distributor matches metadata and these agents cause web materials to be accessed" (Final Action, page 1, final 6 lines). However, as noted on page 9 of the Current Reply, claim 33 recites "making at least part of the second set of personal profiles available," "based upon at least part of the first set of personal profiles and at least part of the second set of personal profiles." First, there is no citation of which elements of Lipkin the Examiner believes to correspond to the elements of claim 33. Secondly, the Examiner does not even indicate that the "web materials" of Lipkin correspond to profiles and are being made available "based upon at least part of" something else that corresponds to profiles and "at least part of" the web materials. The Examiner provided no response to resolve this clear lack of "designat[ing] as nearly as practicable" "the particular part [of the reference] relied on" as required by 37 CFR § 1.104(c).

Since it is unclear what in Lipkin, taken alone or in combination with other art, shows or suggests the above listed claim limitation, the Examiner has not made out a prima facie case of obviousness. The Applicants have not been notified of "the reasons for such rejection, or objection, or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution" as is required by 35 U.S.C. § 132. Therefore, the Applicants respectfully request for the rejections to claim 33 to be withdrawn.

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**C. The Examiner Has Not Met the Requirements of
37 CFR § 1.104(c) or 35 U.S.C § 132 in Regard to Claims 34 or 35**

Applicants also noted in the Current Reply and the Previous Reply that the Examiner has not provided a reasonable indication of what in the prior art or combination of the prior art he believes to show or suggest these limitations and that he has therefore not met the requirements of 37 CFR § 1.104(c) or 35 U.S.C § 132 as described above.

It was noted, on page 10 of the Current Reply and page 14 of the Previous Reply that, claim 34 recites, in combination:

I. "making a set of personal profiles available, each personal profile in the set of personal profiles including a first set of first values for a plurality of information fields, the plurality of information fields relating to commercial transactions."

II. "based upon the at least part of the set of personal profiles, receiving a request to enter into a trusted relationship, receiving a set of trusted relationship information, and sending the set of trusted relationship information in order to facilitate a commercial transaction."

Neither Lipkin nor Dorak show or suggest these features, in combination with the remaining elements of the claims.

In addition, it was noted on page 10 of the Current Reply and page 14 of the Previous Reply, that claim 35 recites, in combination:

I. "providing a network adapted to be used in a set of future commercial transactions, making a set of personal profiles available, the set of personal profiles relating to a set of previous commercial transactions."

II. "based upon the at least part of the set of personal profiles, receiving a request to enter into a trusted relationship, receiving a set of trusted relationship information, and sending the set of trusted relationship information in order to facilitate at least one commercial transaction in the set of future commercial transaction."

As explained above, neither Lipkin nor Dorak show or suggest these features, in combination with the remaining elements of the claims. Again, despite these arguments being presented in each of the Current Reply and Previous Reply, the Examiner provided no further response to the rejections of either claim 33 or claim 35 and instead simply repeated the incorrect statement that "these steps are included in claim 33 and so the analysis is repeated in pertinent part," (Current Action, page 4, paragraph 1) despite the fact that claim 33 does not include, for example, "providing a network." Accordingly, withdrawal of the rejections of claim 34 and 35 is respectfully requested.

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D. Lipkin is Not Related to the Claimed Invention

It was noted on page 7 of the Current Reply and page 10 of the Previous Reply that Lipkin is concerned with "employ[ing] metadata-based profiles to match information with users" (Lipkin, column 113, lines 56-57). In contrast, claim 33, for example, is limited by "making a first set of personal profiles available," "receiving a second set of personal profiles," "making at least part of the second set of personal profiles available," and "receiving a request to enter into a trusted relationship." Because **Lipkin only matches a user profile with information resources** it is clearly unrelated to the present claimed invention of, for example, making portions of profiles available based on a plurality of profiles. Accordingly, withdrawal of the rejections is respectfully requested.

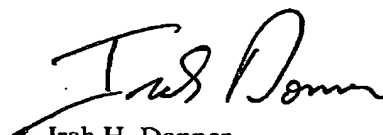
E. The Prior Art Does Not Show or Suggest Receiving a Request to Enter Into a Trusted Relationship Based Upon Person Profiles, as Required by Claims 33, 34, and 35

Claim 33 requires "based upon the at least part of the first set of personal profiles and the at least part of the second set of personal profiles, receiving a request to enter into a trusted relationship" and claims 34 and 35 each require "based upon the at least part of the set of personal profiles, receiving a request to enter into a trusted relationship." As discussed, for example, in the Previous Reply in paragraph 3 of page 11, paragraph 1 of page 13, and paragraph 2 and 3 of page 14, no combination of Lipkin or Dorak shows or suggests "receiving a request to enter into a trusted relationship" based on a personal profile. In support of the Examiner's argument that these limitations are shown, the Examiner, in paragraph 3 of page 5 of the Current Action, the Examiner states "much like the metadata matching feature of the claims at hand," and then cites portions of Dorak that he believes to show or suggest the above cited limitations. However, the Applicants' claims do not recite a "metadata matching feature" nor does the Examiner cite what portion of Dorak shows or suggest that the alleged trusted relationship of Dorak is "based on" "personal profiles". Accordingly, withdrawal of the rejections is respectfully requested.

Respectfully submitted,

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